UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

OCTOBER TERM, 1910.

No. 909.

White-Smith Music Publishing Company,

COMPLAINANT, APPELLANT,

v.

Ira N. Goff Et Al.,

DEFENDANT, APPELLEE.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES
FOR THE DISTRICT OF RHODE ISLAND,
FROM FINAL DECREE (BROWN, J.), NOVEMBER 14, 1910.

TRANSCRIPT OF RECORD.

ALEXANDER P. BROWNE,
BROWNE & WOODWORTH,
for Appellant.

HORATIO E. BELLOWS,
for Appellee.

BOSTON:
PRINTED UNDER DIRECTION OF THE CLERK.
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Circuit Court of the United States.

DISTRICT OF RHODE ISLAND.

IN EQUITY.

No. 2741.

WHITE-SMITH MUSIC PUBLISHING COMPANY

v.

IRA N. GOFF, ET AL.

BILL OF COMPLAINT.

To the Honorable, the Judges of the Circuit Court of the United States for the First Circuit and District of Rhode Island:

White-Smith Music Publishing Company, a corporation duly organized and existing under the laws of the Commonwealth of Massachusetts and having its principal place of business at the City of Boston in said Commonwealth, brings this its bill of complaint against Ira N. Goff and John O. Darling, both of Providence, in the State and District of Rhode Island, and citizens of the United States and of said state and district, co-partners, doing business as music dealers in said Providence; and thereupon your orator complains and says:

1. That on or about the 29th day of June, 1876, a certain agreement in writing, a copy of which is hereunto annexed and marked Exhibit A, and made a part hereof, was duly executed by and between one Eben H. Bailey and White-Smith & Company, music publishers.

2. That said Eben H. Bailey was a skilled musical composer and a citizen of the United States and a resident of said Boston, and that said White-Smith & Company, music publishers, were a firm carrying on said music-publishing business at said Boston.

3. That pursuant to the terms of said contract, Exhibit A, and in fulfilment thereof, the said Eben H. Bailey duly furnished to the said White-Smith & Company, music publishers, an original instrumental composition and the same was duly accepted and the sum of twenty-five dollars was paid by said White-Smith & Company to said Bailey when said composition was published, viz., on or about July 21, 1881.

4. That on or about the said 21st day of July, 1881, said White-Smith & Company duly deposited in the Office of the Librarian of Congress at Washington the title of the said musical composition, viz., "Sparkling Waves, Original Theme with Variations, by E. H. Bailey," claiming the right thereof as proprietors in conformity with the laws of the United States respecting copyrights, and as appears by a certified copy of the original record of copyright under the seal of the Librarian of Congress hereunto annexed and made a part hereof and marked Exhibit B.

5. That also on or before the said 21st day of July, 1881, being the date of first publication of said musical composition, said White-Smith & Company duly deposited in the mail within the United States addressed to the Librarian of Congress, two complete copies of the best edition issued of the said musical composition, and also the legal fee for the recording of copyright thereon.

6. That said White-Smith & Company and their successors in business have caused each and every copy of every edition of the said composition published to be marked with the copyright imprint upon the title page thereof "Copyright, 1881, by White-Smith & Company," all as appears by a printed copy of said composition filed herewith and made a part hereof and marked Exhibit C.

7. That the said White-Smith & Company, music publishers, was a firm consisting of Charles A. White and William F. Smith, that some

time in the year 1890 Daniel L. White, son of Charles A. White, and William F. Smith, Junior, son of said William F. Smith, were taken into said firm as partners and the name and style of said firm was changed to the White-Smith Music Publishing Company.

8. That in June, 1891, said William F. Smith, Senior, died, and that in December, 1891, the entire interest of the said William F. Smith, Senior, deceased, and William F. Smith, his son, was purchased by said Charles A. White and Daniel L. White, who continued business as copartners under the same firm name of White-Smith Music Publishing Company.

9. That in January, 1892, said Charles A. White died, leaving his share of the business to said Daniel L. White, who continued the business as the sole owner thereof under the same name and style, to wit, the White-Smith Music Publishing Company, until April 16, 1897.

10. That on said April 16, 1897, the complainant corporation, White-Smith Music Publishing Company, was formed and acquired all the property and interests of the said firm of White-Smith Music Publishing Company and of said Daniel L. White, and thereby became the sole owner of the copyright in the said musical composition "Sparkling Waves."

11. That said copyright would by law have expired July 21, 1909, unless previously renewed or extended, and therefore that the complainant as owner or proprietor thereof did upon the 14th day of July, 1909, make application to the copyright office for the renewal and extension of said copyright by forwarding a blank form furnished for that purpose by the Register of Copyrights and filled out as shown in the copy hereto annexed and made a part hereof and marked Exhibit D, and by tendering to the Register the statutory fee for such registration, but that the said Register of Copyrights has in writing refused to register your orator's said application for the renewal of its previously existing copyright upon the musical composition "Sparkling Waves," as appears by his letter of February 14, 1910, copy of which is hereto annexed and made a part hereof and marked Exhibit E, and a copy of the decision of the Attorney-Gen-

eral of the United States referred to in said letter is hereto annexed and made a part hereof and marked Exhibit F.

12. That since said July 14, 1910, and prior to the filing of the bill of complaint herein, the defendants have, and without the permission or license of your orator, offered for sale and sold at said Providence, copies, and threaten to continue to so offer for sale and sell copies of said musical composition "Sparkling Waves," in infringement of the copyright and exclusive right of publication and sale of your orator therein.

13. That said copyrighted musical composition being the subject matter of this litigation is of great value and exceeds in value the sum of one thousand dollars, exclusive of interest and costs.

To the end therefore that your orator may obtain relief in the premises in this Honorable Court, and because it is without remedy elsewhere, it humbly prays:

I. That the said Ira N. Goff and John O. Darling may be made defendants to this bill and compelled to answer each and every allegation therein contained as fully as if directly interrogated as to each (but not under oath, an answer under oath being waived.)

II. And your orator prays your Honors to grant unto your orator writs of injunction under the seal of this Honorable Court, directed to the said Ira N. Goff and John O. Darling, their agents and servants, enjoining them, and each of them, from copying, publishing, selling, or offering for sale your orator's said copyrighted musical composition, or any colorable imitation thereof, and that they may be likewise so enjoined pending the determination of this suit.

III. That the said Ira N. Goff and John O. Darling, by the decree of this Court, may be compelled to account for and pay over to your orator all the profits which the defendants have derived or shall have derived from any copying, publishing, selling, or offering for sale of the said musical composition as aforesaid, and also to pay the costs of this suit, and for such other and further relief as the equity of the case or the

Statutes of the United States may require and to this Court may seem just.

IV. And further, to the end that equity may be done and that the relief herein prayed for, and all other relief that it may be righteous in the premises to administer, may be afforded your orator, may it please your Honors such relief fully to grant and to award against the said Ira N. Goff and John O. Darling, writs of subpœna of the United States, commanding them, on a day certain to be named and under a certain penalty, to be and appear in this Honorable Court, then and there to answer all and singular the premises, and to stand to, perform, and abide such further order, direction and decree as may be made against it.

And your orator, as in duty bound, will ever pray, &c.

BROWNE & WOODWORTH,
Solicitors for Complainant.

ALEX. P. BROWNE,
of Counsel.

STATE OF MASSACHUSETTS,
COUNTY OF SUFFOLK, } ss.
CITY OF BOSTON.

Daniel L. White, being duly sworn, deposes and says that he is the President of the White-Smith Music Publishing Company; that he has read the foregoing bill of complaint and that he knows the contents thereof to be true of his own knowledge, except as to the matters therein stated to be alleged upon information and belief, and as to those matters he believes it to be true.

DANIEL L. WHITE.

Sworn to before me this 27th day of May, 1910.

WALTER A. STONE,
Notary Public.

EXHIBIT A.

BOSTON, June 29, 1876.

Memo. of Agreement, between Eben H. Bailey, of the first part, and Mess. White, Smith & Co., Music Publishers, of the second part. The party of the first part, hereby agrees to furnish the party of the second part, Eight, (8) MSS. of his own original Instrumental Compositions each year, during the term of this contract, and upon the acceptance of which, the party of the second part agrees to pay the sum of ($25.00) Twenty-five dollars each, as soon as published. This contract to remain in force 3 years from above date, or until June 29, 1879, and during which time, the party of the second part, shall hold, the exclusive right, and title to all original inst'l compositions or transcriptions by the party of the first part, who shall not in any case offer them to any other party or publisher, either under his own name or "nom-de-plume." It is also agreed by the party of the first part, to give to the party of the second part, all his trade and influence in furtherance of this contract.

Witness. (Signed) EBEN H. BAILEY.

(Signed) FRANK E. CRANE. (Seal)

WHITE SMITH & CO.

EXHIBIT B. A

1881, No. 11336 M.

LIBRARY OF CONGRESS, TO WIT:

BE IT REMEMBERED,

That on the.....21st.....day of....July....., 1881.., White, Smith & Co....., of Boston....., have deposited in this Office the title of a Musical Composition....., the title or description of which is in the following words, to wit:

Sparkling Waves. Original Theme with Variations by.....
E. H. Bailey.....
.....
.....
.....
.....
.....
.....

the right whereof they claim as proprietors in conformity with the laws of the United States respecting Copyrights.

A R Spofford
Librarian of Congress.

I hereby certify that the foregoing is a true copy of the original record of copyright. In witness whereof, the seal of this Office has been hereto affixed this seventeenth.....day of March....., 1910...

Thowald Solberg,
Register of Copyrights.

Copyright Office of the United States of America,
Washington, D. C.

(1,ix, 1909—200.)

EXHIBIT D.

Application for RENEWAL can only be made during the LAST YEAR of the present copyright. R1*

Name of claimant	Application for renewal received
Author and title	
	Entry } No.
	Class }
	Cash No. $

Application for the RENEWAL of a Copyright Subsisting in Any Work.

Register of Copyrights, Washington, D. C.....Date, July 14, 1909.

Application is hereby made within this the last year of the copyright now subsisting in the work hereinbelow described (in accordance with the provisions of section 24 of the Act of March 4, 1909), for the renewal of the copyright for the renewal term of 28 years from the date when the said copyright will expire. 50 cents (statutory fee) is also inclosed.

The renewal copyright is claimed by ...., us, as* assignee of the author. .....

Name and address of renewal claimant } WHITE-SMITH MUSIC PUBLISHING CO.,..... 62 & 64 Stanhope St., Boston, Mass.....

Title of** Musical Composition, for which this renewal copyright is desired:

"Sparkling Waves," Original Theme with Variations, for Pianoforte.

Name of author, E. H. BAILEY.

Date of original registration of title, July, 1881.

Name of original claimant, WHITE, SMITH & CO.

* When the author is living and application is made by or for him, the words "the author" should be inserted in the blank above left for that purpose after the words "copyright is claimed by me, us, as."

If the author is not living and application is made (a) by the widow or widower, then the words "the widow of the author" or "the widower of the author" should be inserted.

If (b) by the child or children of the deceased author, then the words "the child of the deceased author" or "the children of the deceased author" should be inserted.

If (c) by the executors of the will of the author, then the words "the executors" should be inserted.

If (d) by the next of kin of the author who is not living, then the words "the next of kin of the author who is not living" should be inserted.

If (e) by the proprietor of a composite work upon which copyright was originally secured by the proprietor thereof, then the words "the proprietor" should be inserted.

** State here whether the work is a "book," a "dramatic composition," or a "musical composition," etc.

Copyright Act of March 4, 1909.

Provision for the Extension of Existing Copyright.

Sec. 24. That the copyright subsisting in any work at the time when this Act goes into effect may, at the expiration of the term provided for under existing law, be renewed and extended by the author of such work if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then by the author's executors, or in the absence of a will, his next of kin, for a further period such that the entire term shall be equal to that secured by this Act, including the renewal period: Provided, however, That if the work be a composite work upon which copyright was originally secured by the proprietor thereof, then such proprietor shall be entitled to the privilege of renewal and extension granted under this section: Provided, That application for such renewal and extension shall be made to the Copyright Office and duly registered therein within one year prior to the expiration of the existing term.

Exhibit E.

LIBRARY OF CONGRESS

COPYRIGHT OFFICE

In reply quote file
No. TS-CCL

WASHINGTON

February 14, 1910.

Gentlemen:

From time to time we have received from you applications for the renewal or extension of subsisting copyrights in behalf of an assignee.

The question whether such registrations could be made has, as you know, been submitted to the Attorney General of the United States, and he decides, under date of February 3d, that registrations for the renewal or extension of copyright under Sec. 24 of the new copyright law can only be made in the name of one of the designated beneficiaries, and not in the name of an assignee.

This opinion is ruling upon the Copyright Office, and under the circumstances registration cannot be made upon the fifty-seven applications received from you and in due season the fee will be returned.

Respectfully

T. Solberg,
Register of Copyrights.

White-Smith Music Publishing Co.,
Boston, Mass.

OPINION FEB. 3, 1910,

ATTORNEY GENERAL

ON

COPYRIGHT RENEWALS

BY

ASSIGNEE OF AUTHORS.

Exhibit F.

COPYRIGHT—RENEWALS AND EXTENSIONS.

The renewal or extension of copyrights under section 24 of the act of March 4, 1909 (35 Stat. 1080), can be secured only by the person or persons specifically designated in the statute, and can not, therefore, be granted to the assignee of the copyright.

The privileges of copyright are purely statutory, and the right to a renewal or extension of a copyright must be found within the statute.

Department of Justice,
February 3, 1910.

Sir: I have the honor to acknowledge receipt of your communication of December 10, 1909, with certain documents from the register of copyrights inclosed, from which it appears that a number of applications have been made for renewal or extension of copyrights under section 24 of the act of March 4, 1909 (35 Stat. 1080), said applications being divided into two general classes, to wit:

(1) Applications made by assignees under direct assignments of the renewal or extension term from the persons named in the statute as entitled to renewals or extensions.

(2) Applications made by assignees who purchased the copyrighted work, either when the original copyrights were secured or subsequent thereto, and who also took assignments of the copyrights.

And you ask my opinion whether such renewals or extensions can be granted at the instance of the assignees.

The privileges of copyright are purely statutory, and when one seeks a renewal or extension of a copyright his right thereto must be found within the statute. The provisions of the act of March 4, 1909 (35 Stat. 1075), which bear upon this question, are the following:

"Sec. 8. That the author or proprietor of any work made the subject of copyright by this act, or his executors, administrators, or assigns,

shall have copyright for such work under the conditions and for the terms specified in this act:

"SEC. 23. That the copyright secured by this act shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any post-humous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author), or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright. And *provided further*, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work when such contribution has been separately registered, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.

"SEC. 24. That the copyright subsisting in any work at the time when this act goes into effect may, at the expiration of the term provided for under existing law, be renewed and extended by the author of such

work if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then by the author's executors, or in the absence of a will, his next of kin, for a further period such that the entire term shall be equal to that secured by this act, including the renewal period: *Provided, however*, That if the work be a composite work upon which copyright was originally secured by the proprietor thereof, then such proprietor shall be entitled to the privilege of renewal and extension granted under this section: *Provided*, That application for such renewal and extension shall be made to the copyright office and duly registered therein within one year prior to the expiration of the existing term."

It will be observed that section 8 declares who may procure original copyrights; that section 23 provides who may procure renewals of copyrights *secured by this act*, and that section 24 prescribes who may procure a renewal or extension of a copyright "subsisting in any work at the time when this act goes into effect * * * for a further period such that the entire term shall be equal to that secured by this act, including the renewal period."

Each of these sections is specific in its terms, and leaves but little or no room for construction. In the first it is expressly provided that the assigns of an author or proprietor shall have a copyright for the work upon complying with the conditions specified in the act. In the second it is provided that if the work be posthumous or composite upon which the original copyright was secured by the proprietor, or if copyrighted by a corporate body otherwise than as assignee or licensee of the individual, or by an employer for whom such work is made for hire, the proprietor may procure the renewal, but that in all other cases it must be procured by the author, if living, or if dead, by the widow, widower, or children, or if they also be dead, by the author's executors, if there be a will, or otherwise by his next of kin; and the third section mentioned, the one here applicable, requires the extension or renewal to be procured by the author, if living, or if dead, by the persons and in the order mentioned in the preceding section, except as to composite works which were originally

copyrighted by the proprietor, in which case the proprietor may secure the extension.

The very fact that each of these sections enumerates with such particularity the persons who may exercise the privilege of securing copyrights and having them renewed and the order in which the right vests, and that in these particulars the sections materially differ from each other, shows that the persons enumerated are exclusive of all others and that it was not the purpose of Congress to confer the right upon any person or persons not therein specifically mentioned.

This view is well sustained by the authorities. The act of February 3, 1831 (4 Stat. 436), gave the right of renewal to the author, if living, or if dead, to his widow, child, or children. In commenting upon this provision of the act and a provision of a previous act, the court, in *Pierpont* v. *Fowle*, 19 Fed. Cases, 652,659, said:

"Both refer to authors alone, and not their assigns, as entitled. They do not even embrace in terms, express assignees of a second term, made before the second term begins, and the last act does not name assigns at all. So the extension allowed under the act of 1831, of a copyright taken out under that act, looks entirely to the author and his family, and not to assignees."

By the act of July 8, 1870, section 88 (16 Stat. 212; Rev. Stats., sec. 4954), the right of renewal was given to the author, or his widow or children, if he be dead; and with reference to the right of renewal under this statute, in Drone on Copyrights, page 261, it is said:

"Besides granting copyright to the author or owner of a work, and the assignee of such person, for twenty-eight years, the existing statute of the United States provides that, at the end of that term, the author, inventor, or designor, if living, or his widow or children if he be dead, may secure a renewal of the copyright for fourteen years. As neither the owner of a work nor an assignee is mentioned in this section, it would seem that the copyright for this additional term will not vest *ab initio* in such person. But elsewhere the ground is taken, that when the renewed copyright has been secured by the author, or his widow or children, it may be transferred to an assignee."

And again, on page 333:

"Section 4954 of the Revised Statutes, which provides for a renewed term of copyright, makes no mention of an assignee. The view has been elsewhere expressed that the copyright for this term will not vest *ab initio* in an assignee, but only in the author, his widow, or children. Hence, when an author has assigned his entire interest in a work, and has thereby or otherwise barred himself and his family from securing the copyright for the second term, the assignee is powerless to make the renewal for his own benefit."

However, I do not wish to be understood as approving the assumption here expressed that the author, or in case of his death, the other persons mentioned in the statute as being entitled to the right of renewal may bar themselves of that right. Such right is created by the most explicit terms of the statute, and no recognition is there given of a previous assignment of the copyright, or a conveyance of the author's right in the copyrighted work, or of any kind of contract that he may have made with reference thereto. When the application for renewal is presented to the register of copyrights, the only thing left for his consideration is whether the applicant is one of the persons designated in the statute. But who may possess the legal or equitable right in the copyright after renewal is another question, and one which is to be determined by the terms of such contract as the author or other person or persons entitled to the renewal may have entered into before or after the renewal is had.

Much reliance is placed by the applicants on the case of *Paige* v. *Banks*, 7 Blatch. 152, and 13 Wall. 608,614. The facts in that case were, that Paige, the testator of the plaintiffs, had on October 7, 1828, entered into a contract with Gould and Banks, whereby he was to furnish them in manuscript the reports of his court for publication, and that they were to "have the copyright of said reports, to them and their assigns forever." Under the act of 1790 the term of copyright was fourteen years, with right of renewal for fourteen years additional, the assigns of an author having the right to procure both the original copyright and the renewal; and on January 5, 1830, registration for the original copyright was made

in the names of Gould and Banks. On February 3, 1831, an act was passed which extended all copyrights then existing to a term of twenty-eight years, with right of renewal for fourteen years longer, but the renewal privilege was restricted to the author, or, if he be dead, to his widow, or child or children. When the original term expired on January 5, 1858, both Gould and Banks and Paige went through the usual forms to procure a renewal of the copyright. Paige subsequently died, and thereafter his executor filed a bill against Gould and Banks to enjoin them from further printing and vending the work, and for an account of the profits after January, 1858. The bill was dismissed by both the court below and the Supreme Court.

The decision turned entirely upon the construction of the contract between Paige and Gould and Banks, the sole question considered being whether, under the contract, Paige had parted with the entire interest in the work, this question being thus stated by the Supreme Court:

"Independent of any statutory provision the right of an author in and to his unpublished manuscripts is full and complete. It is his property, and like other property is subject to his disposal. He may assign a qualified interest in it, or make an absolute conveyance of the whole interest. The question to be solved is, Do the terms of this agreement show the intent to part with the whole interest in the publication of this book, or with a partial and limited interest?"

And, after an analysis of the contract, the court held that—

"As between the parties to the agreement the absolute interest was conveyed by the stipulation of Paige, that he would furnish the manuscript for publication."

In considering the clause in the contract "and the said Gould and Banks shall have the copyright of said reports to them, their heirs, and assigns forever," the court said:

"It is not covenanted that the publishers should take out the copyright, nor is there any express agreement for an assignment to them by Paige, if he should take it out. Undoubtedly the provision, that the publishers 'should have the copyright,' would authorize them to apply for it,

and if Paige had taken it out in his own name it would have inured to their benefit. But, as between Paige and the publishers, the rights of the latter could not be estimated differently, whether they had or had not availed themselves of the provisions of the act."

The act of 1790 expressly provided that the assignees of an author of a work could procure a copyright thereof, and hence the statement of the court that the stipulation in the contract with reference to the copyright authorized Gould and Banks to apply for it. Therefore, the point of the decision was, that Paige having transferred his entire interest in the work to Gould and Banks, and they having thereby acquired a perpetual right to publish and sell the same, *independent of the question of* copyright, they could not be enjoined from its publication and be made to account for the copies sold after the expiration of the original term. The question here presented was not considered in that case, and the case is given attention only because it is cited by applicants as conclusive authority in their favor.

The comments of the committee upon sections 23 and 24, which accompanied the bill when reported, show conclusively that it was not intended that the assigns of a work should have the right of renewal, except as specifically provided for therein. Among other things, the committee said:

"It was urged before the committee that it would be better to have a single term without any right of renewal, and a term of life and fifty years was suggested. Your committee, after full consideration, decided that it was distinctly to the advantage of the author to preserve the renewal period. It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and *the law should be framed as is the existing law, so that he could not be deprived of that right.*

* * * * * * * *

"Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or, in the absence of a will, his next of kin. It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal.

"In the case of composite or cyclopedic works, to which a great many authors contribute for hire, and upon which the copyright was originally secured by the proprietor of the work, it was felt that the proprietor of such work should have the exclusive right to apply for the renewal term. In some cases the contributors to such a work might number hundreds and be scattered over the world, and it would be impossible for the proprietor of the work to secure their co-operation in applying for the renewal."

It readily appears how the right of renewal may be a valuable asset to an author, though he may have previously parted with all interest in the copyrighted work. When renewed, like all other copyrights, it is assignable. (Sec. 42 of act; Drone on Copyrights, 333.) And no doubt it may be the subject of a valid contract before renewal, which would carry the equitable, if not the legal, title thereto when renewed. And, therefore, the owner of the work who, after the expiration of the original term, would be without protection, would, if the work be a valuable one, gladly pay a reasonable price for the extension. At any rate, the right of extension was clearly given for the benefit of the author, and the provision should not be construed against him, unless the language of the statute clearly requires such construction, which it does not.

It is not intended in this opinion to determine any question of law which relates to the relative rights of authors and their assigns, and such rights are mentioned only by way of illustration or argument. The matter here for determination is one solely for the guidance of the Register

of Copyrights in granting renewals of copyrights; and, for the reasons above stated, I hold that he should be governed by the language of the statute, and grant a renewal to no one other than the person or persons mentioned therein. The applicants here in question are the owners of the works by purchase, and assignees of the original copyrights, and in some cases, have taken assignments of the renewal terms. But in neither case does the statute authorize the extension to be made in the name of the assignee, and the applications should, therefore, be disallowed.

Respectfully,

J. A. FOWLER,

Assistant Attorney-General.

Approved:

GEORGE W. WICKERSHAM.

The PRESIDENT.

DEMURRER.

The joint and several demurrer of Ira N. Goff and John O. Darling, defendants, to the bill of complaint of White-Smith Music Publishing Company, the above named complainant.

These defendants by protestation, not confessing all or any of the matters and things in the complainant's bill of complaint contained to be true, in such manner and form as the same are therein set forth and alleged, do demur to said bill and for cause of demurrer show that the complainant has not in and by its said bill made or stated such a case as entitles it in a court of equity to any relief against these defendants or either of them as to the matters contained in said bill, or any of such matters.

Wherefore, and for divers other good causes of demurrer appearing in said bill, the defendants do demur thereto and humbly demand the judgment of this court whether they shall be compelled to make any further or other answer to the said bill, and pray to be hence dismissed with their costs.

IRA N. GOFF,
JOHN O. DARLING.

I, Horatio E. Bellows, of counsel for the defendants Ira N. Goff and John O. Darling, do certify that in my opinion the foregoing demurrer of the defendants to the bill of complaint in the above entitled case is well founded in point of law.

HORATIO E. BELLOWS.

UNITED STATES OF AMERICA,
DISTRICT OF RHODE ISLAND. } ss.

Ira N. Goff and John O. Darling being duly sworn depose and say that they are the defendants in the above entitled case, and that the foregoing demurrer is not interposed for delay.

IRA N. GOFF,
JOHN O. DARLING.

Subscribed and sworn to before me June 8, 1910.

WILLIAM E. TEFFT,
Notary Public.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

OCTOBER TERM, 1910.

No. 909.

WHITE-SMITH MUSIC PUBLISHING COMPANY,
COMPLAINANT, APPELLANT,

v.

IRA N. GOFF ET AL.,
DEFENDANT, APPELLEE.

TRANSCRIPT OF RECORD OF CIRCUIT COURT.

[Filed in Circuit Court of Appeals December 2, 1910.]

United States of America,
District of Rhode Island.

At a Circuit Court of the United States, holden at Providence within and for the District of Rhode Island, on the fifteenth day of November, in the year of our Lord one thousand nine hundred and ten.

Present:

The Honorable ARTHUR L. BROWN, *District Judge.*

No. 2741, Equity.

WHITE-SMITH MUSIC PUBLISHING COMPANY

v.

IRA N. GOFF ET AL.

The Bill of Complaint in this case was filed in the clerk's office on the second day of June, 1910, and is in the words and figures following: —

BILL OF COMPLAINT.

[Filed June 2, 1910.]

[Memorandum. The Bill of Complaint, as printed in this Transcript of Record, beginning on page 3, is here inserted. William P. Cross, *Clerk.*]

Thereafter, to wit, on the eighth day of June, 1910, there was filed by the respondent the following

DEMURRER.

[Filed June 8, 1910.]

[Memorandum. The Demurrer, as printed in this Transcript of Record, beginning at page 23, is here inserted. William P. Cross, *Clerk.*]

The cause came on for hearing upon the demurrer to the bill before the Honorable Arthur L. Brown, District Judge, on the twenty-third day of June, 1910, and was fully heard and argued by counsel for the respective parties.

On the fifth day of August, 1910, the Opinion of the Court was announced, sustaining the demurrer, and on the fourteenth day of November, 1910, there was entered the following Final Decree: —

FINAL DECREE.

Brown, J. This cause having come on to be heard on the bill and demurrer, and having been argued by the respective parties, It is ordered, adjudged and decreed that the demurrer be sustained and that the bill of complaint be, and hereby is, dismissed and that the complainant pay the defendant $24.25, as costs of suit.

Entered as the decree of this court by order thereof (Brown, J.), November 14, 1910.

WILLIAM P. CROSS, *Clerk.*

Thereafter, to wit, on November 19, 1910, the complainant filed its petition for appeal and assignment of errors, together with a bond to party on appeal, and the said petition to appeal was allowed and the said bond to party on appeal was approved by the Honorable Arthur L. Brown, District Judge.

On the said nineteenth day of November, 1910, a citation on appeal was issued, returnable to the Circuit Court of Appeals for the First Circuit on the seventeenth day of December, 1910.

PETITION FOR APPEAL AND ASSIGNMENT OF ERRORS.

[Filed November 19, 1910.]

The above-named complainant, White-Smith Music Publishing Company, believing itself to be aggrieved by the decree of said court, made and entered November 14, 1910, in the above-entitled case, hereby appeals from said decree to the United States Circuit Court of Appeals of the First Circuit, and it hereby assigns the errors asserted and intended to be urged as follows: —

1. That the court erred in denying the contention of the complainant that in order to carry out the provisions of Section 8 of the new copyright law (United States Compiled Statutes, 1909, page 1296) a general power of renewal by a proprietor must necessarily be read into Section 24 of said Act.

2. That the court erred in denying the contention of the complainant that the use in said Section 8 of the expression, "for the terms," indicates that both author and proprietor are to be entitled to an extended term as well as to an original term.

3. That the court erred in holding that if the complainant relies upon rights coming to him through assignment, the bill should state that at some time a vested right of renewal was in the assignor.

4. That the court erred in holding that an attempt to read into said Section 24 an implication that the proprietor shall also have a general right of renewal additional to that specifically provided would throw the act into inconsistency and confusion.

5. That the court erred in holding that whatever may be the renewal rights of others, the statute grants only limited rights of renewal to a proprietor.

6. That the court erred in holding that upon the case made by the bill, the complainant is not entitled to a renewal of his copyright for a further period of 28 years after the expiration of his original term.

7. That the court by the decree appealed from, has, in violation of Article 5 of the Amendments of the Constitution of the United States, deprived this complainant of its property without due process of law.

8. That if the interpretation by the court of said sections 8 and 24 of said new copyright law (United States Compiled Stat-

utes, Section 8) is correct, then the said law is in violation of Article 5 of the Amendments of the Constitution of the United States, in so far as it operates to deprive this complainant of its property without due process of law.

9. That the court erred in sustaining the demurrer.

10. That the court erred in dismissing the bill.

The complainant prays that this its appeal may be allowed, and that a transcript of the record and proceedings and papers in said case upon which said decree was made, duly authenticated, may be sent to the United States Circuit Court of Appeals for the First Circuit.

ALEX. P. BROWNE,
Solicitor and of Counsel for Complainant.

Appeal allowed November 19, 1910. ARTHUR L. BROWN, J.

BOND TO PARTY ON APPEAL.

Know all men by these presents, that we, White-Smith Music Publishing Company, of Boston, in the Commonwealth of Massachusetts, as principal, and Daniel L. White, of Winthrop, in said Commonwealth, as surety, are holden and firmly bound unto Ira N. Goff and John C. Darling, both of Providence, in the State and District of Rhode Island, in the full and just sum of three hundred (300) dollars, to be paid to the same Ira N. Goff and John C. Darling, their certain attorneys, executors, administrators or assigns, to which payment well and promptly to be made, we bind ourselves, our heirs, executors, administrators and successors, jointly and severally by these presents.

Sealed with our seals and dated this sixteenth day of November, in the year of our Lord one thousand nine hundred and ten.

Whereas, lately at a term of the United States Circuit Court for the District of Rhode Island, in a suit in equity depending in said court between White-Smith Music Publishing Company, complainant, and Ira N. Goff and John C. Darling, defendants, the bill of the said complainant was dismissed, and the said complainant having obtained an appeal to remove said cause to the United States Circuit Court of Appeals for the First Circuit, to reverse the decree in the aforesaid suit, and a citation directed to the said Ira N. Goff and John C. Darling, citing and admonishing them to be and appear in the said United States Circuit Court of Appeals for the First Circuit, in the City of Boston, Massachusetts, on the second day of January, 1911.

Now, the condition of the above obligation is such, that if the said White-Smith Music Publishing Company shall prosecute its appeal to effect, and answer all damages and costs if it fail to make its appeal good, then the above obligation to be void; else to remain in full force and virtue.

WHITE-SMITH MUSIC PUBLISHING CO.,
Treasurer.

DANIEL L. WHITE.

Approved: D. L. WHITE, *President.*

Approved: November 19, 1910. ARTHUR L. BROWN, J.

OPINION OF THE CIRCUIT COURT

ON DEMURRER TO BILL.

AUGUST 5, 1910.

BROWN, J. The complainant charges that the defendants have violated its copyright in a musical composition entitled, "Sparkling Waves. Original Theme with Variations. By E. H. Bailey."

For the purposes of demurrer it may be assumed that the complainant corporation as proprietor became the owner of a valid copyright in this musical composition for the original term of 28 years, expiring July 21, 1909. Just prior to the expiration of the original term, upon July 14, 1909, the complainant, as assignee of the author, sought to extend the copyright for a further or renewal term of 28 years. The register of copyrights refused registration for a renewal or extension of copyright, under Section 24 of the new copyright law (Act of March 4, 1909), on the ground that it could be made only in the name of one of the designated beneficiaries and not in the name of an assignee.

To support the proposition that as proprietor the complainant has a right of renewal, the complainant cites the following portions of "An Act to Amend and Consolidate the Acts Respecting Copyright"; passed March 4, 1909: —

"SEC. 8. That the author or proprietor of any work made the subject of copyright by this Act, or his executors, administrators, or assigns, shall have copyright for such work, under the conditions and for the terms specified in this Act."

"SEC. 24. That the copyright subsisting in any work at the time when this Act goes into effect may, at the expiration of the term provided for under existing law, be renewed and extended by the author of such work if still living, or the widow, widower,

or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then by the author's executors, or in the absence of a will, his next of kin, for a further period such that the entire term shall be equal to that secured by this Act, including the renewal period. Provided, however, that if the work be a composite work upon which copyright was originally secured by the proprietor thereof, then such proprietor shall be entitled to the privilege of renewal and extension granted under this section. Provided, that application for such renewal and extension shall be made to the copyright office and duly registered therein within one year prior to the expiration of the existing term."

The complainant contends that in order to carry out the provisions of Section 8, a general power of renewal by a proprietor must necessarily be read into Section 24; also that the use, in Section 8, of the expression, " for the terms," indicates that both author and proprietor are to be entitled to an extended term as well as an original term. Such a construction of the act is by no means necessary, since author or proprietor are to have copyright under the conditions specified in the act. The intent of Congress to distinguish between the renewal right of a proprietor and of an author is evident both from Section 23 and from Section 24.

The right of an assignee to a renewal can hardly be greater than the right of an author. The right of renewal secured to an author, both under Section 23 and under Section 24, is conditional upon his survival. Upon his decease the right of renewal does not follow the author's estate, but is given to the widow, widower or children of the author, or if they be not living, then to his executors, or in the absence of a will, to his next of kin. The statute is peculiar in that it does not provide that in case of the decease of the author the renewal right shall follow the ordinary rules of law in case of testacy or intestacy, but designates beneficiaries who take the right directly from the statute. It is to be noticed that both in Section 23 and Section 24 the author's administrators are excluded.

According to the complainant's contention the assignee of an author would have a right of renewal even if the author had deceased, although the author's right of renewal was conditional upon his survival and did not pass to his estate but directly to

widow or children by operation of the statute. The bill does not allege whether or not the author survived, so as to have a right of renewal under the statute. If the complainant relies upon rights coming to him through assignment it seems essential that the bill should state that at some time a vested right of renewal was in the assignor.

Upon a consideration of the entire act due effect can be given to Section 8 as applicable primarily to original copyrights wherein the author and proprietor stand upon equal footing, and secondarily to renewals under the conditions subsequently set forth, wherein author and proprietor do not stand on similar footing. As the statute both in sections 23 and 24 deals specifically with the question of renewal by a proprietor, and grants the right of renewal to a proprietor only in connection with specific kinds of works, an attempt to read into Section 24 an implication that the proprietor shall also have a general right of renewal, additional to that specifically provided, would throw the act into inconsistency and confusion. The provisos of both sections 23 and 24 would be hard to explain upon the complainant's theory that it was intended that a proprietor should have a general right of renewal in all classes of works after the expiration of the original term.

It is unnecessary for the purposes of this case to decide whether under Section 24 an author, if living, or, if not living, any of the other designated persons, can be entitled to an extended term during which they may prevent a proprietor who has enjoyed an original term in his own name from continuing publication.

Ordinarily, when an author sells his manuscript outright for a fixed sum, it would be understood that the purchaser had a right to publish, and either to secure a copyright or not, as he saw fit. By electing not to secure a copyright, and by publishing without notice of copyright, he would deprive the author of no property right. It is difficult to say upon what principle the exercise of his rights as a proprietor to secure copyright for himself for the original period of 28 years should give to the author or his widow or children the right to exclude the proprietor after the twenty-eighth year from the right to publish which he acquired by the purchase of the manuscript.

By Section 2 the rights of the author or proprietor of an unpublished work are preserved. If the purchaser of an unpublished work has the right of publication, with or without copyright, it is difficult to see upon what principle that right can be lessened or reduced to a limited term by his registration of a copyright as proprietor for his own exclusive benefit. In *Paige* v. *Banks*, 13 Wall. 608-615, it was said: —

"As between the parties to the agreement the absolute interest was conveyed by the stipulation of Paige that he would furnish the manuscript for publication. Paige could no longer do any act, after such delivery for publication inconsistent with the absolute ownership of the publishers."

A construction of the copyright law which gives to an author or to members of his family, or others, a right to an independent term of copyright succeeding, and inconsistent with, a proprietor's right to continue publication, is full of difficulty. It may be well to remember that the copyright law does not grant the original right of publication, but only serves to make exclusive rights which previously existed. In this respect it is similar to the patent right. *Paper Bag Patents Case*, 210 U. S. 424-425; *U. S.* v. *Bell Telephone Co.*, 167 U. S. 224-249; *Bloomer* v. *McQuewan*, 14 How. 539-549; *Blount Mfg. Co.* v. *Yale & Towne Mfg. Co.*, 166 Fed. Rep. 555. Although a patent contains terms which imply a grant to make, use and vend, the right of an inventor to make, use and vend his invention is not granted, but only made exclusive, by the patent.

The author of an unpublished book or musical composition, by virtue of his proprietory right, may assign his property and confer his rights upon another. If he has done so, then a statute subsequently passed which should create in the author, the assignor, or in any third person, a right which would destroy the previously conveyed right of publication would be open to serious doubts of constitutionality. The copyright statute is concerned not with the creation of original rights of publication, but with making exclusive rights originating in the familiar principles of private property.

Section 24 provides that the "copyright subsisting in any work may be renewed and extended." If the proprietor's term expires in 28 years, and a new term of 28 years is granted to a third per-

son to the exclusion of the proprietor, it is an unusual use of language to call this the renewal or extension of the copyright subsisting. A copyright implies a person in whom the right resides, and the act apparently contemplates continued protection of an existing right rather than the creation of a new and inconsistent right springing into effect 28 years after the original registration.

But even should we assume that, upon a proper construction of the statute, such right to a new and inconsistent term exists, this would not extend the right of the proprietor, since whatever may be the renewal rights of others the statute grants only limited rights of renewal to a proprietor. Whether, upon the expiration of the proprietor's original term, the work becomes free to the public so that the proprietor has no longer an exclusive right under the statute, but still a right in common with the public, or whether at the conclusion of the proprietor's original term a new term may arise which is inconsistent with the further right of a proprietor, is immaterial to a decision upon this demurrer.

Whatever view may be taken of the statute, I am of the opinion that it fails to support the complainant's main proposition that upon the expiration of his original term a proprietor merely by force of Section 8 is entitled to a renewal thereof for a further period of 28 years.

As the bill fails to allege any copyright in the complainant at the time of the defendants' acts, the demurrer must be sustained.

CITATION ON APPEAL.

United States of America, ss.

The President of the United States,

To Ira N. Goff *and* John O. Darling, *both of Providence, in the State of Rhode Island, and citizens of said State*, Greeting:

You are hereby cited and admonished to be and appear in the United States Circuit Court of Appeals for the First Circuit, in the city of Boston, Massachusetts, on the seventeenth day of December next, pursuant to an appeal duly obtained from a decree of the Circuit Court of the United States for the District of Rhode Island, wherein White-Smith Music Publishing Company, a corporation duly organized under the laws of the Commonwealth of Massachusetts is appellant, and you are appellees, to show cause,

if any there be, why the said decree, entered against the said appellant, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable ARTHUR L. BROWN, Judge of the Circuit Court of the United States for the District of Rhode Island, this nineteenth day of November, in the year of our Lord one thousand nine hundred and ten.

[SEAL] ARTHUR L. BROWN, J.

ACKNOWLEDGMENT OF SERVICE OF CITATION.

UNITED STATES OF AMERICA,
DISTRICT OF RHODE ISLAND, SS.

Due and sufficient service of this citation is hereby acknowledged this twenty-sixth day of November, 1910.

HORATIO E. BELLOWS,
Solicitor for Appellees.

CLERK'S CERTIFICATE.

UNITED STATES OF AMERICA,
DISTRICT OF RHODE ISLAND.

I, William P. Cross, Clerk of the Circuit Court of the United States for the District of Rhode Island, do hereby certify that the foregoing is a true copy of the record in the cause entitled,

No. 2741, EQUITY.

WHITE-SMITH MUSIC PUBLISHING COMPANY

v.

IRA N. GOFF ET AL.,

in said Circuit Court determined, the Complainant's Petition for Appeal and Assignment of Errors, Bond to party on Appeal, the original Citation on Appeal issued in said cause, with the Acknowledgment of Service thereon, and the Opinion of the Circuit Court sustaining the Demurrer in said cause.

In testimony whereof, I hereunto set my hand and affix the seal of said Circuit Court, at Providence, in said district, this twenty-sixth day of November, A.D. 1910.

[SEAL] WILLIAM P. CROSS, *Clerk.*

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

OCTOBER TERM, 1910.

No. 909.

WHITE-SMITH MUSIC PUBLISHING COMPANY,

COMPLAINANT, APPELLANT,

v.

IRA N. GOFF ET AL.,

DEFENDANTS, APPELLEES.

BRIEF FOR COMPLAINANT, APPELLANT.

ALEX. P. BROWNE,
BROWNE & WOODWORTH,
Counsel for Complainant, Appellant.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

OCTOBER TERM, 1910.

No. 909.

WHITE-SMITH MUSIC PUBLISHING COMPANY,
Complainant, Appellant,

v.

IRA N. GOFF ET AL., Defendants, Appellees.

BRIEF FOR COMPLAINANT, APPELLANT.

The question herein involved is as follows:

Pursuant to an agreement between them, a composer of music composed a musical piece and sold the manuscript without any reservation to a publisher. The publisher thereafter published the piece, copyrighting it under the law of 1870. The term of this copyright expired July 21, 1909.

Just prior to the expiration of the original term, viz., on July 14, 1909, the publisher sought to extend his copyright for a further or renewal term of twenty-eight years under the new copyright law in effect ~~June~~ July 1, 1909, and made application to the Copyright Office at Washington for such renewal.

This application was refused registration upon the ground that it could be properly made only in the name of the author or other beneficiary designated in Sec. 24 of the Act, and could not be made by the owner or proprietor of the composition.

The new law provides that —

> "No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act

with respect to deposit of copies and registration of such work shall have been complied with."

The Circuit Court accordingly sustained a general demurrer and dismissed the bill, which was for infringement against another music publisher who had published the piece after the expiration of the original copyright term.

From this action the present appeal is taken.

THE PRACTICAL QUESTION.

If the ruling of the court below be sustained, the effect upon the property rights of the music publishers of the country will be most serious and injurious.

Cases like the present one are arising almost daily, wherein by reason of the length of time of the original term of twenty-eight years, it is no longer possible to obtain the co-operation in renewal of the composer or other beneficiary, and other cases are frequently arising in which such co-operation is refused except upon the payment of a sum in addition to that paid for the original manuscript. In the first class of cases the publisher is left without possibility of further copyright protection, and in the second class his obtaining such protection is dependent upon the new bargain, if any, which he can make.

THE COMPLAINANT'S CONTENTION.

The complainant contends that in accordance with the rule laid down by the Supreme Court of the United States in *Paige* v. *Banks*, 13 Wall. 614, —

a. The right of an author in and to his unpublished manuscript is full and complete at the common law and independent of any statutory provision.

b. It is his property and like any other property is subject to his disposal.

c. He may assign a qualified interest in it or make an absolute conveyance of the whole interest.

Now, in the present case the production of the manuscript of the

song in question and its sale to the complainant was pursuant to an ordinary common law contract.

Under this contract, if it was a contract of manufacture and sale, the title to the manuscript was vested in the author until he sold it to the publisher and it follows therefore that at the time the author sold the manuscript to the publisher, there was vested in him —

a. His common law right of ownership in the manuscript.

b. His statutory rights of copyright.

It therefore follows (see *Paige* v. *Banks, supra*) that when the author made an absolute sale of the manuscript to the publisher, he also assigned all his rights of copyright to the publisher. As under the Act of 1870 the author had two rights of copyright, one an original right and the other a renewal right, it follows that the purchaser outright of the manuscript became thereby the assignee of both of the author's statutory rights in regard thereto, the original right and the renewal right.

The publisher exercised his statutory right of original copyright and shortly before its expiration further attempted to exercise his renewal right by making application therefor pursuant to the terms of the new law.

Was such application by the publisher sufficient to secure such renewal right regardless of the refusal by the Register of Copyright to register it? We maintain that it was.

RENEWAL UNDER THE NEW LAW.

It is to be noticed at the outset that the new law does not specify *by whom* the renewal application shall be made, and we submit that the absence of such specification is important, for if, as was argued above, the author's right of renewal passed by equitable assignment to the purchaser of the manuscript at the time of the purchase, then he, the purchaser, stands in the shoes of the author and may, therefore, himself make the application for renewal of copyright.

ASSIGNABILITY OF RENEWAL RIGHT.

We have heretofore treated the contract between author and publisher as one of manufacture and sale, but it may be treated as a contract of employment for hire.

The new copyright law is remarkable in that it in terms provides that the word "author" shall include an employer in the case of works made for hire, and therefore it must follow that, under the renewal section of the new law, the word "author" includes such employer.

If the present contract is one of employment, the complainant's case is clear, and it is not perceived that there is any logical reason why a publisher who has caused a musical composition to be written for and delivered to him under a contract of hiring, should have any greater or different common law right to, or title in, the work than if he had caused the same work to be produced and delivered to him under a contract of manufacture and sale. There is no reason whatever, that we can see, why the publisher in the first instance should be held to have the author's right to renew the contract because he, the publisher, was his employer, but should be held not to have acquired the author's right to renew if his contract was one of manufacture and sale.

We shall contend that the provision that the word "author" shall include the employer is merely a recognition of a previously existing right and not the creation of a new one, and that the new Copyright Act cannot be validly held to discriminate between works acquired under a contract of employment and those acquired under a contract of manufacture and sale. The argument may be syllogistically expressed as follows:

a. All right of renewal of copyright must follow the title to the manuscript at the time of publication.

b. If the author part unreservedly with the title in the manuscript before publication, he at the same time parts with all right of renewal of copyright therein.

c. Therefore, either the complainant in this case, at the time of and by virtue of his purchase of the manuscript, became the assignee

of the author's renewal right, or, by virtue of being an employer, the right of renewal became vested in him the moment the piece was written.

PRIOR DECISIONS.

The present Copyright Act of 1909 being of such recent date, we have not been able to find any decision of the courts concerning it which would throw any light upon the present question. The same is true also of the Act of 1870. We have been unable to find any pertinent decision arising under the provisions of that Act.

We have already referred to the case of *Paige* v. *Banks*, 13 Wall. 614, and we shall rely extensively upon the opinion of the court in that case.

In *Paige* v. *Banks*, the plaintiff, a law reporter, agreed to furnish to the defendant, a law-book publisher, manuscript reports of the opinions of a certain court for the period of five years, for the purpose of their publication, and it was further agreed that the publisher should have the copyright in such reports forever. The publisher in turn agreed to pay and did pay, to the reporter, a thousand dollars for each volume published. The publisher in the year 1830 took out a copyright as proprietor under the Act of May 31, 1790.

In 1858 this copyright expired, but in the meanwhile a new Act of Congress had been passed, being the Act of February 3, 1831, and under this new Act both the reporter and the publisher renewed the copyright.

The suit arose by a bill in equity brought by the reporter to enjoin the publisher from infringement of the reporter's renewal copyright. Judge Blatchford held that the suit could not be maintained. He held that the sale of the manuscript for a thousand dollars carried with it all rights of the author, including the right to take out the original copyright and the right to renew the same. In the Supreme Court of the United States, as appears from the briefs of counsel set forth in the report, the same argument was advanced as is now advanced in the opinion of the Attorney-General. We refer particularly to the extract from the brief of counsel for appellant, numbered "2" at page 612 of the report. It was there pointed out that the original Act of Congress of 1790 contained the following provision:

"And if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him, or them, his or their executors, administrators or assigns, for the further term of fourteen years, provided he or they shall cause the title thereof to be a second time recorded and published in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years aforesaid."

It was also pointed out that the Act of 1831 contained the following provision:

"Sec. 2. And be it further enacted that if, at the expiration of the aforesaid term of years, such author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more than one person, be still living, and a citizen or citizens of the United States, or resident therein, or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child, or children, for the further term of fourteen years, provided, that the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term."

We quote as follows from the opinion of the court:

"Independent of any statutory provision the right of an author in and to his unpublished manuscript is full and complete. It is his property, and like any other property, is subject to his disposal. He may assign a qualified interest in it, or make an absolute conveyance of the whole interest. The question to be solved is, do the terms of this agreement show the intent to part with the whole interest in the publication of this book, or with a partial and limited interest?

"The agreement on the one side is 'to furnish, in manuscript, the reports of said court for publication', with an additional clause that the publishers 'shall have the copyright of said reports to them and their assigns forever'. The cause or consideration of this agreement is a stipulation by the other side for a certain sum of money, and the performance of certain duties in connection with the publication.

"It is insisted by the appellants that a just interpretation confines the agreement to a mere assignment of the interest in such copyright, as is provided for in the act of 31st May, 1790; that this was the law in force when the contract was entered into; that the fourteen years therein provided for, with the right to a prolongation of fourteen years more, is all that the publishers, at most, are entitled to, and that they are excluded necessarily from the benefit of the provisions conferred by the act of the 3rd February, 1831, granting to authors an additional extension of fourteen years.

"In our view this is too narrow a construction. The fair and just interpretation of the terms of the agreement indicates unmistakably that the author of the manuscript, in agreeing to deliver it for publication at a stipulated compensation, intended to vest in the publishers a full right to property thereto.

"The manuscript is delivered under the terms of the agreement 'for publication'. No length of time is assigned to the exercise of this right, nor is the right to publish limited to any number of copies. The consideration is a fixed sum of $1000. Whether one or one hundred thousand copies were published the author was entitled to receive, and the publishers bound to pay, this precise amount.

"As between the parties to the agreement the absolute interest was conveyed by the stipulation of Paige, that he would furnish the manuscript for publication. Paige could no longer do any act after such delivery for publication inconsistent with the absolute ownership of the publishers. But it was proper, for the protection of the publishers, that they should be in position to assert the remedies given by the law against intruders, and it is

to this end it is added in the agreement, 'and the said Gould & Banks shall have the copyright of said reports to them, their heirs, and assigns forever'. It is not covenanted that the publishers should take out the copyright, nor is there any express agreement for an assignment to them by Paige, if he should take it out. Undoubtedly the provision, that the publishers 'should *have* the copyright', would authorize them to apply for it, and if Paige had taken it out in his own name it would have enured to their benefit. But, as between Paige and the publishers, the rights of the latter could not be estimated differently, whether they had or had not availed themselves of the provisions of the act."

Paige v. *Banks*, 13 Wallace, 614.

It is to be noticed that although the Act of 1831 merely provided that the copyright shall be continued to the author or his widow and child or children, yet in the very next section of the Act we find the following:

"That in all cases of renewal of copyright under this Act, such author *or proprietor* shall within two months from the date of said renewal cause a copy of the record thereof to be published", etc.

This publication under the Act of 1831 was the only formality to be observed with regard to the renewal of the copyright beyond the record of the title of the work and the complying with the regulation as to original copyright, and we ask the court to note that whereas the right of renewal is in terms secured only to the author or his widow or children, yet the Act provides that in cases of renewal the "author or proprietor" shall attend to the publication of the newspaper notices.

The only other case of which we are aware in any way touching upon this question of the construction of the Act of 1831, is that of *Pierpont* v. *Fowle*, 2 Woodbury & Minot, 29.

This, again, was a bill in equity brought by an author against a publisher, this time seeking an accounting for sales during the renewal term of copies of a work, the manuscript of which had been

sold to the publisher. In this case, the Court, by Judge Woodbury, held as follows:

> "In respect to both copyrights also, the complainant conveyed *eo nomine*, not a term of twenty-eight years; nor one, as long as he should be entitled; nor all his interest of every kind in the book or its manuscript; but simply as to the first, 'the copyright of said book', and as to the last, the copyright of it 'shall be considered the joint and equal property of said P. and F.' The only copyright then existing or taken out for either was for fourteen years only. One contract was dated July 21st, 1823, and one July 12, 1827. That copyright, which had been then taken out, was the subject-matter of the contracts; no words are used looking beyond that; no consideration was paid or talked of beyond that. There was no mutuality beyond that."
>
> *Pierpont* v. *Fowle*, 2 Woodbury & Minot, 42.

NATURE OF THE EXTENDED TERM.

The original copyright, even under the new law, attaches automatically (see Sec. 9 of the Act) by virtue of publication of the work with the notice of copyright required by the Act, and we submit that, in like manner, the renewal of a copyright attaches automatically upon application for it made to the Copyright Office and duly registered therein. We further submit that the Register of Copyrights is not a judge; that he has no judicial power whatever; that he is merely a registering officer, and that when the true owner of the right of renewal of an existing copyright makes application for its registration the same must be registered by the Register of Copyrights.

> "The Librarian of Congress possesses no power in the premises; he simply receives the title when it is delivered or forwarded to him and makes a record of it in his office, and receives the two copies of the publication when published, and which must be forwarded to him within ten days after the publication is

made, and makes a record of the receipt of the copies. The Librarian issues no certificate, or anything in the nature of patent ; he simply makes a record, and whenever called upon has to make a certificate of whatever the records of his office show towards a compliance with the terms of the law. The rights of the party holding a copyright, therefore, depend wholly on whether he has in fact complied with the terms of the law or not, and not upon the fact that he has obtained a certificate from the Librarian."

Chicago Music Co. v. *J. W. Butler Paper Co.*, 19 Fed. Rep. 758.

THE CONSTITUTIONAL QUESTION.

By the seventh and eighth assignments of error we have sought to raise the question of the constitutionality of the new Copyright Act so far as it affects the class of copyright renewals of which the present case furnishes an instance.

Our argument upon this point in brief is this:

If we are right in our contention that the author's renewal privilege under the Act of 1870 became vested in the publisher by reason of the transaction between them, then, as we submit, this *renewal* right was a property right existing in the publisher at the time of the passage of the new Act.

Unless therefore the new Act is capable of receiving such a construction as to permit the publisher to have protection under it in the enjoyment of his property right, then the new Act is unconstitutional in so far as it has operated to deprive this complainant of its property without due process of law.

The effect of the decision of the court below sustaining the demurrer is that the publisher complainant has no longer any copyright in his musical composition, not because such renewal right has not attached, but because under the phraseology of the new Copyright Law, as construed by the Circuit Court, the complainant is incapable of complying technically with the statutory requirements regarding renewal, and this through no fault of his own.

We submit that a construction may be given to the new Act which will protect the complainant's renewal right in the composition and that the Act should be so construed by this court and the decree of the lower court sustaining the demurrer should be reversed.

ALEX. P. BROWNE,
BROWNE & WOODWORTH,
Counsel for Complainant, Appellant.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

OCTOBER TERM, 1910.

No. 909.

WHITE-SMITH MUSIC PUBLISHING COMPANY,

Complainant, Appellant,

vs.

IRA N. GOFF ET AL.,

Defendants, Appellees.

BRIEF FOR DEFENDANTS, APPELLEES.

HORATIO E. BELLOWS,

for Appellees.

CIRCUIT COURT OF THE UNITED STATES.
DISTRICT OF RHODE ISLAND.

IN EQUITY, No. 2741.

WHITE-SMITH MUSIC PUBLISHING COMPANY,
Complainant, Appellant,

vs.

IRA N. GOFF ET AL.,
Defendants, Appellees.

BRIEF FOR DEFENDANTS ON DEMURRER TO BILL OF COMPLAINT.

This is an appeal from a Decree sustaining a Demurrer to the Bill of Complaint brought in the District of Rhode Island by the White-Smith Music Publishing Company against Ira N. Goff and John O. Darling, copartners at Providence, Rhode Island, which Bill prayed for an injunction to restrain infringement of Copyright of a musical composition entitled "Sparkling Waves."

The essential facts disclosed by the Bill of Complaint are as follows: Eben H. Bailey, a composer, entered into an agreement upon the twenty-ninth day of June, A. D. 1876, to convey to the firm of White-Smith & Company, publishers, musical compositions. One such composition was later conveyed to said firm and copyrighted by them as proprietors July 21, 1881. At the period of these transactions, the firm White-Smith & Company was composed of Charles A. White and William F. Smith. By death and purchase the personnel of said firm thereafter was changed until in January, 1892, Daniel L. White became the sole owner of the business. Upon April 16, 1897, the Complainant Corporation acquired from Daniel L. White and became the sole owner of the Copyright of said musical composition. Upon July 14, 1909, or one week prior to the expiration of the Copy-

right term, the Complainant made application for a renewal of said Copyright, which was upon February 14, 1910, refused by the Registrar of Coyprights.

The Bill sets forth that subsequently to July 14, 1909, the defendants sold and offered for sale copies of said musical composition.

These defendants maintain that the Bill fails to allege any Copyright in the complainant at the time of defendants' acts, and that the Registrar of Copyrights lawfully refused to record complainant's musical composition, and that by virtue of this refusal suit cannot be maintained conformably to Section 12, of the new Copyright Law.

The law in force when complainant's original rights were acquired was, so far as pertinent to this case, embodied in Sections 4952 and 4954, Revised Statutes (Act. July 8, 1870).

Section 4952 provides in effect that the "*author, inventor, designer, or proprietor,*" and *the executors, administrator or assigns of any such person,*" shall, upon complying with the law, have sole liberty of publishing.

Section 4954 reads as follows: "The author, inventor, or designer, if he be still living and a citizen of the United States and resident therein, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. . ."

The class of persons defined in Sec. 4952, who may procure an original copyright, is less restricted than the class at liberty to renew the same enumerated in Sec. 4954. From the latter class is excluded the "proprietor" and "the executors, administrators, or assigns;" and for them are substituted the "widow or children" of the author, inventor, or designer.

Under the terms of Sec. 4954, not only is the assignee of a proprietor ineligible as an applicant for copyright renewal, but even the proprietor himself is excluded.

The limitation of the copyright privilege to the family of the author appears to have been the policy of the statutes since the Act of 1831. Prior to that time the period of protection inclusive of the renewal period was only twenty-eight years.

The Act of May 31, 1790 (1 Stat. at Large, Sec. 1, page 124),

provided an original term of fourteen years, "And if, at the expiration of said term, the author or authors, or any of them be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or *assigns*, for the further term of fourteen years," provided the title be again recorded and published.

The Act of Feb. 3, 1831 (4 Stat. at Large, page 436), extends the period of the original term to twenty-eight years, but limits the class entitled to renewals as follows:

Sec. 1 enumerates those entitled to original copyright to the "author or authors," "and the executors, administrators, or legal *assigns* of such person or persons."

Sec. 2 of this act provides that if at the expiration of the twenty-eight year term the "author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more than one person, be still living . . . or, being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child or children, for the further term of fourteen years," provided the title be again recorded.

Sec. 16 of this act, which provides for the renewal of existing copyrights theretofore obtained, in no wise broadens the class of applicants enumerated in Sec. 2, of this act.

The Act of Feb. 3, 1831, therefore, like its successor, the Act of July 8, 1870, excludes from the renewal period both the assignee and the proprietor.

Upon July 1, 1909, the copyright law went into effect, under which, on July 14, 1909, the complainant, as assignee of the original proprietor, attempted to renew the term of the copyright here sued upon. Act of Mar. 4, 1909 (35 Stat. 1075).

Referring to the Act of March 4, 1909, last referred to, Section 8 reads as follows:

"That the author or proprietor of any work made the subject of copyright by this Act, or his executors, administrators, or assigns, shall have copyright for such work, under the conditions and for the terms specified in this Act."

This section would appear to indicate at once who are entitled to a copyright for the original twenty-eight year term, following prior copyright acts by including in such original term the author, or pro-

prietor, or his executors, administrators, or *assigns*. The section is introductory in nature, apparently, in that it states generally that the copyright to the enumerated individuals is under the conditions and for the terms specified in this Act. These conditions and terms are treated in detail in Sections 23 and 24.

Sec. 23 refers to "copyright secured by this Act," and presumably refers only to renewals of copyrights originally registered under this Act. If so, the section is foreign to the present case. But even assuming the section not to be so limited the complainant is not included among its beneficiaries, since the subject matter of complainant's musical composition cannot be classified as a posthumous work or a periodical, cyclopaedic, or composite work, or a work copyrighted by a corporate body, or by "an employer for whom *such work* is made for hire." The word, "such work," appears to refer exclusively to the preceding words, periodical, cyclopaedic, composite, etc, and does not include a production like Exhibit C. Thus, while it is evident that certain proprietors have the privilege of a renewal term, the complainant is not in that class. Furthermore, the agreement, Exhibit A, can hardly be called a contract of hiring. The section confers no privileges upon assignees.

Sec. 24 appears to be the only one directed to the matter in hand. This section refers to "copyright subsisting in any work at the time this Act goes into effect." Those enumerated as eligible applicants are the author, or the widow, widower, or children of the author, if the author be not living, or, if they be dead, then the author's executors, or, in the absence of a will, the author's next of kin. Provision is made also for a renewal by a proprietor of *composite works*.

This law, like those of 1831 and 1870, limits the privilege of renewals to a class more limited than those competent to originally register. Those persons enumerated in Sec. 24, in addition to those referred to in Rev. St. Sec. 4954 are widowers, executors, and next of kin. Neither the proprietor, nor the assignee of an author or of a proprietor is herein mentioned, and the absence of these persons from a carefully enumerated list of eligibles seems to indicate by itself an intent to exclude them. Furthermore, the inclusion of executors and exclusion of administrators in this section as well as in Sec. 23, indicates a studied purpose to benefit only the author and his family.

Complainant's exposition of the law requires that the power of renewal on the part of the proprietor or assignee should be "read into" section 24.

Such an interpretation is unnecessary since the three sections are reconcilable as they stand. Such a construction is repugnant because it requires the Court to reconstruct rather than interpret the law. Finally, by so treating the section, inconsistency results from the fact that one of the provisos of the section relates to the right of a limited class of proprietors to renewal, namely, proprietors of "composite" works.

The interpretation of the law asked by defendants is that supported by the cases.

Reference in this connection is particularly made to *Pierpont* v. *Towle*, 2 Woodbury and Minot's Reports, page 41, *et seq.*, a case decided in this circuit, which holds that assignees under the statute of 1831 could not renew, unless the assignment specifically indicated such an intention, and a clear and adequate consideration be paid for the extended term. This decision carefully reviewed prior statutes and decisions.

The conclusions of the leading text-book writer on copyright, as to the right of any other than the author and his family to secure a renewal of copyright is adverse to complainant, *Drone on Copyright, pages 261, 333.*

Regarding the allegation by complainant that the decree and the Court's interpretation of Sec. 8 is a violation of the Fifth Amendment of the constitution, it is believed that such position is untenable.

A copyright cannot be sustained as a right existing at common law; but as it exists in the United States it depends wholly on the legislation of Congress.

> *Banks* v. *Manchester*, 128 U. S. 244, 252.
> *Holmes* v. *Hurst*, 174 U. S. 82, 85.
> *Stevens* v. *Gladding*, 17 How. 447.
> *Wheaton* v. *Peters*, 8 Pet. 1, 16.

The right of the proprietor or assignee of a copyright is not, therefore, an inherent or natural right. Nor can their right be properly called a vested right in property. And the right must be of such a character to come within the scope of the Fifth Amendment. The right of or in the property must be other than expectant or contingent. A vested right has been thus defined: "It would seem that a right cannot be considered a vested right unless it is something more than such a mere expectation as may be based upon an anticipated continuance of the present general laws, "Cooley's Constitutional Limitations," page 511.

The complainant raises as a practical point the hardship of acquiring an assignee to purchase the extended copyright term from the author. This hardship is no greater than that which would result to the author if at the end of a prosperous term of twenty-eight years, the author had no opportunity of securing something additional to the usual paltry sum which he received in the first instance. In the present case, *twenty-five dollars.*

The complainant contends that when the author sold his manuscript there vested in the publisher not only the right of ownership in the manuscript, *but the statutory rights of copyright.* We maintain that the publisher acquired only *such rights of copyright* in addition to the manuscript as the statute declares appertains to a proprietor or assignee.

Section 62 of the new law provides that the word "author shall include an employer in the case of works made for hire." Complainant's counsel does not appear to claim that the present contract is one of employment, but holds that it is illogical that the employer publisher should be given a privilege greater than the publisher whose rights are secured by contract. The congressional committee certainly suggest a practical reason as follows:

"In the case of composite or cyclopedic works, to which a great many authors contribute for hire, and upon which the copyright was originally secured by the proprietor of the work, it was felt that the proprietor of such work should have the exclusive right to apply for the renewal term. In some cases the contributors to such a work might number hundreds and be scattered over the world, and it would be impossible for the proprietor of the work to secure their co-operation in applying for the renewal."

The complainant cites *Paige* v. *Banks* in support of the theory that the sale of a manuscript to a publisher divests the author of all rights therein including the right of *renewal of copyright.* This conclusion is not supported by the decision referred to. The act of 1790, which was in force when Gould & Banks acquired the manuscript, specifically gave the assignee a right to the renewal term. The question at issue was whether under the stated contract Paige had or not parted with his entire interest in the work. The conclusion was that he had parted with the entire work, that Gould and Banks had acquired by virtue of *the contract* a perpetual right to publish the same, and therefore could not be enjoined by Paige from so publishing.

It is believed that the purpose of the new law is primarily to secure exclusive benefit to the author and to his natural beneficiaries, and that the law should be construed consistently with such a spirit.

Respectfully submitted,

HORATIO E. BELLOWS,
of Counsel for Defendants.

APPEARANCE.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

NO. 909 OCTOBER TERM, 1910.

White-Smith Music Publishing Company,

Complainant, Appellant,

v.

Ira N. Coff et al.,

Defendants, Appellees.

The Clerk will enter my appearance as Counsel for the Appellants.

Alex. P. Brown
Brown & Woodworth

☞ This should be signed by a member of the Bar of this Court. (The appearance of a member of the Bar of the Supreme Court or of any Circuit Court of the United States will be entered *subject to subsequent admission to practice in this Court.*) The firm name may be added.

No. 909.

United States Circuit Court of Appeals

FOR THE FIRST CIRCUIT.

October Term, 1910.

APPEARANCE

OF

Alex. P. Browne

FOR

White-Smith Music Pub. Co.,

Complainant, Appellant.

Filed Dec. 2 1910.

APPEARANCE.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

NO. 909 OCTOBER TERM, 1910.

White-Smith Music Publishing Company,

Complainant, Appellant,

v.

Ira N. Goff et al.,

Defendants, Appellees.

The Clerk will enter my appearance as Counsel for the Appellees.

Horatio E. Bellows,
Providence R. I.

☞ This should be signed by a member of the Bar of this Court. (The appearance of a member of the Bar of the Supreme Court or of any Circuit Court of the United States will be entered *subject to subsequent admission to practice in this Court.*) The firm name may be added.

No. 909.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE FIRST CIRCUIT.

OCTOBER TERM, 1910.

APPEARANCE

OF

Horatio E. Bellows

Ira N. Coff et al.,
Defendants, Appellees.

FILED Dec. 2 1910

Original

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FIRST CIRCUIT.

OCTOBER TERM, 1910.

No. 909.

WHITE-SMITH MUSIC PUBLISHING COMPANY,
COMPLAINANT, APPELLANT,
v.
IRA N. GOFF ET AL.,
DEFENDANTS, APPELLEES.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF RHODE ISLAND.

BEFORE PUTNAM, LOWELL AND ALDRICH, JJ.

OPINION OF THE COURT.

MARCH 1, 1911.

PUTNAM, J. This appeal grows out of a bill in equity brought by the complainant, the White-Smith Company, against the respondents, Goff and Darling, alleging infringement of a copyrighted musical composition. The complainant is the publisher, and not the author. It claims a statutory extension of a copyright as proprietor under sections 4952 and 4954 of the Revised Statutes. It offered registration under the statute, and, although registration was refused, yet it fully complied with the requirements of law, and is entitled to maintain this suit if it had any statutory right to the extension. Whether at this time the author was living does not appear. The respondents make no claim under any copyright. The complainant acquired its original rights under the following contract: —

Filed March 1, 1911
Francis M. Fogarty
Clerk.

BOSTON, June 29, 1876.

Memo. of Agreement between Eben H. Bailey, of the first part, and Mess. White, Smith & Co., Music Publishers, of the second part. The party of the first part hereby agrees to furnish the party of the second part, Eight (8) MSS. of his own original Instrumental Compositions each year, during the term of this contract, and upon the acceptance of which, the party of the second part agrees to pay the sum of ($25.00) twenty-five dollars each, as soon as published. This contract to remain in force 3 years from above date, or until June 29, 1879, and during which time, the party of the second part, shall hold the exclusive right and title to all original inst'l compositions or transcriptions by the party of the first part, who shall not in any case offer them to any other party or publisher, either under his own name or "nom-de-plume." It is also agreed by the party of the first part, to give to the party of the second part, all his trade and influence in furtherance of this contract.

Witness. (Signed) EBEN H. BAILEY.
(Signed) FRANK E. CRANE. (Seal)
WHITE SMITH & CO.

As the bill alleged no other right than what we have stated, it was demurred to, and the decision of the Circuit Court was in favor of the respondents, on the ground that the complainant had no statutory interests in the extension.

Sections 4952 and 4954 of the Revised Statutes applied to the copyright at the time it was taken out: —

"Sec. 4952. Any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person shall, upon complying with the provisions of this chapter, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same: and, in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors may reserve the right to dramatize or to translate their own works."

"Sec. 4954. The author, inventor, or designer, if he be still living and a citizen of the United States and resident therein, or his widow

or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term."

When the copyright thus acquired under section 4952 expired, the act approved March 4, 1909, 35 Stat. 1075, was in force, of which so much of the twenty-fourth section as is pertinent at this point reads as follows: —

"Sec. 24. That the copyright subsisting in any work at the time when this Act goes into effect may, at the expiration of the term provided for under existing law, be renewed and extended by the author of such work if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then by the author's executors, or in the absence of a will, his next of kin, for a further period such that the entire term shall be equal to that secured by this act, including renewal period."

The complainant maintains that the result in the Circuit Court was to deprive it of a vested right; but, as the language of the two statutes which we have cited was for this purpose essentially the same, no such question can arise. Moreover, as is thoroughly settled by the Supreme Court, all rights of copyright in the United States are purely statutory, whatever they may once have been in England; and it is not so easy to understand how there can be a vested right under a public statute which has not actually accrued, and which lies only in the future. This proposition, however, we can pass by.

It is to be noted that in each statute the grant of the original copyright is to the author or proprietor, while as to the provision for an extension the word "proprietor" is studiously stricken out. Neither is it true that the provision for the extension in either statute operates automatically or in any line which recognizes a continuing right. While the words "renewed and extended," in their proper and ordinary construction, relate to a continuing right, yet the fact that, if the author is not living, the "widow, widower or children" of the author are entitled to the additional term makes

the provision of each statute in reference thereto strictly personal, and not really and truly a renewal or extension. Therefore, neither statute on its face provides really and truly an extension to the author, his assigns, executors and administrators, but a new grant to the author or others enumerated as we have said.

In this connection we will observe that the complainant relies on the word "proprietor" appearing in what follows in the same section 24, namely: "Provided, however, that, if the work be a composite work upon which copyright was originally secured by the proprietor thereof, then such proprietor shall be entitled to the privilege of renewal and extension granted under this section." This has reference, of course, to the provision about composite work in section 23 of the same act of March, 1909; yet by its own implication it clearly defeats the proposition of the complainant, because, if that were correct, this proviso would not be necessary in order to entitle a mere proprietor to the privilege of renewal and extension under any circumstances whatever. Indeed, whether the position of the complainant or the respondents be correct, the word "proprietor" comes in legitimately because, in connection with the renewal, the persons who control the right thereto, whether widow, widower or the author himself, may during the year prior to the expiration of the existing term nominated in section 24, assign the right to renewal, so that the then proprietor may make the new registration required, and take out the extension in his own name. Further, there is nothing in all these implications suggested by the complainant which, on any just rule of construction, can set aside the plain phraseology of the statute as to any particulars concerned therein. It is, therefore, at least clear that, by the express terms of the statutes, whether the one existing when this copyright was taken out or the one existing when the extension was applied for, no one except the author or the members of his family or his executors could ordinarily apply for the extension; and this independently of any question for whose benefit the author or the other applicant might hold the copyright when acquired.

However, it is well to show that this is not merely a technical condition precedent, but lies at the bottom of a long-continued and

purposely-intended series of statutes. The first section of the original copyright act of May 31, 1790, 1 Stat. 124, provided that the original copyright might be taken out by a "citizen or citizens," "his or their executors, administrators, or assigns." In the same section, and as a part of the same subject-matter, the statute gave, using exactly the same language, to "a citizen or citizens," "his or their executors, administrators, or assigns," a further term of fourteen years. There was here no reference to members of the author's family, or to anyone who was not in the line of succession or in privity according to the rules of law, but only a repetition of exactly the same persons and successors to whom the first term was given. Therefore, without there being any specific authoritative construction given thereto by the Supreme Court, it was properly assumed that the further term of fourteen years was strictly an extension or continuation of the original right, and flowed out of the same in accordance with the ordinary rules of law controlling the devolution of property; so that there was nothing to indicate, as a matter of public policy or otherwise, by the way of pointing out *eo nomine* any particular persons to whom the extensions should be granted, that a copyright might not be assigned alike for the original term and for all its extensions, improvements, and all other incidentals, precisely as an ordinary patent for an invention may be assigned. There was nothing to indicate any public policy to the contrary. This first appeared in sections 2 and 16 of the act of February 3, 1831, 4 Stat. 436, 439. Section 2 related to copyrights obtained after that statute went into effect. It broke up the continuity of title, and gave the right of renewal to the widow or child or children. This clearly recognized the fact that, unlike the view entertained early in England, a copyright is purely a matter of statutory grant, as has been settled ever since *Wheaton* v. *Peters*, 8 Pet. 591, decided in 1834, and recognized by at least several statutes by which Congress has arbitrarily granted copyrights to persons who had not entitled themselves thereto under any existing law. Here, then, was an entirely new policy, completely dissevering the title, breaking up the continuance in a

proper sense of the word, whatever terms might be used, and vesting an absolutely new title *eo nomine* in the persons designated.

Congress thus proceeded on the theory contained in the original statute of Anne, by virtue of which, at the expiration of the first copyright term, the sole right of printing or disposing of copies "returned to the authors thereof, if living." On the well-settled principles of the common law, and also on the well-settled principles applicable to ordinary things, the right of publication having been returned to the original author ceased to exist, and was dissolved into its original elements, precisely as a right of way from Blackacre across Whiteacre ceases to exist when the same title in fee to each parcel vests in the same owner. Whatever might occur afterwards would be entirely a new grant, and, whatever the language used in section 2 of the act of 1831, such was the condition, and whatever further rights arose were disconnected from the original right. Section 2 referred to copyrights which first came into being after that statute went into effect, as we have said. Section 16 of the same act related to copyrights which had been secured prior to the act of 1831, and gave an extension of those copyrights. This did in truth assume to vest the new right in the widow, etc., if the author was not living, and cut out a mere proprietor by omitting his name. It was to this stage of the legislation of the United States that *Paige* v. *Banks*, 13 Wall. 608, related, the original copyright having been taken out in 1828. We will refer to this case again.

In every act since that of 1831, this method of vesting the right to an extension *eo nomine* has been persisted in. The purpose of these provisions is singularly illustrated by the fact that all the author's administrators are shut out; but his executors, whom he may appoint at his will, are let in. This continues in sections 23 and 24 of the present act of 1909. With this there accumulates a very considerable amount of foreign legislation to which it may be well to call attention in this connection. According to a note made by Mr. George T. Curtis in what is described by Judge Clifford as his very valuable work on copyright, at page 25, it seems to have been the policy of nearly all the civilized world to secure the exten-

sion of a copyright to the author or his family, including England, France, Holland, Belgium and Prussia. There are at least sentimental reasons for believing that Congress may have intended that the author, who according to tradition receives but little for his work, and afterwards sees large profits made out of it by publishers, should later in life be brought into his kingdom. At any rate such seems to be the purpose of the legislation in the countries referred to by Mr. Curtis, and such was clearly the purpose in much of the earlier legislation in the Colonies. It is true that, in the line of what was enacted by Congress in 1790, the Continental Congress, in May, 1783, recommended only that the various Colonies should renew the copyright term first given to the author and his legal successors and assigns; but Connecticut in the same year provided, as did the statute of Anne, that at the end of the first term the right of publication should return to the author, and Maryland, Pennsylvania, Georgia, New York and New Jersey did the same.

It can hardly be conceived that such statutory declarations do not indicate a deepseated policy which not even the author can defeat. If what statutes we have cited left any question, it would seem to be removed by section 23 of the act of 1909. This defines the limited class of proprietors who may secure the extended term, namely, where there is a composite work as already spoken of, or a corporation, or an employer for whom the work was made for hire. To strengthen the effect of this it appears in the body of this classification that even a corporation, when it is the assignee or licensee of an individual, is excluded. Of course, section 23 does not directly operate here, but it intensifies the interpretation which we have given to section 24 and other like statutory provisions preceding it. Consequently, except for *Paige* v. *Banks*, 7 Blatchf. 152, and 13 Wall. 608, we should be clearly of the opinion that the discussion we have made fully disposes of the case in favor of the respondents here, on the ground of a thoroughly established public policy, supported by sufficient reasons in that behalf. Nevertheless, we are bound to accept *Paige* v. *Banks*, to the effect that there was a certain class of cases to which our reasoning would not apply.

There the publishers secured the extension: and there was the

peculiar fact that the author contracted to furnish them the manuscripts of his publications, which were judicial reports, with a provision that they should have the right thereof "to them and their assigns forever." Looking through the opinion in the Circuit Court, as well as that in the Supreme Court, it might be said that the effect was simply to estop the author as against the perpetual right of the publishers, and nothing else; and it is also to be observed that in that case an extended copyright had in fact been taken out by the author, so that the author might have been said to have held the copyright in trust for the publishers.

In the present case the letter of the statute had not been complied with by any application for an extended copyright made by the author, or by any of those designated in connection with such application if he was not living. It may be that we would be justified in disposing of the present case on that distinction; but it would be so unsatisfactory a distinction as hardly to be worth acceptance by a court of law. If an application by the author was merely a condition precedent, it is plain to us that in some cases it might be a practical denial to the publisher of all right, because, during the short period given for securing the extension, it would be quite impracticable for him to enforce a trust and to establish a right thereto by litigation. Such a construction would apparently make the statute a practical failure as to accomplishing one of its intended purposes. If the statute intended the publisher to secure the benefit of the copyright, it undoubtedly would have so declared directly, instead of hinting at it indirectly through the author. Therefore, such a suggestion does not seem to be a reasonable one.

While, of course, not much weight as to the construction of a statute can fairly be given to the report of a committee of one branch of Congress bringing in a bill which is afterwards enacted into the statute in question, yet, where we have such an apparent statutory policy as we have here, in the light of the explanations we have made, such a report clearly declaring that policy must attract decided attention. In this case the present statute of 1909 was accompanied in the House of Representatives with a report, No. 2222, 60th Congress, 2d Session, which was very elaborate,

and explained fully the provisions of the bill which accompanied it. It explained positively sections 23 and 24 which are in issue here, and which, as we have shown, practically re-enact what had preceded them, beginning with the act of 1831. After referring generally to the wisdom of a renewal of the term of a copyright, it said: —

"It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum. If the work proves to be a great success and lives beyond the term of twenty-eight years, your committee felt that it should be the exclusive right of the author to take the renewal term, and the law should be framed as is the existing law, so that he could not be deprived of that right."

It again said: —

"Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work, if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or, in the absence of a will, his next of kin. It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to bequeath by will the right to apply for the renewal."

What is thus said about the administrator is directly in line with what we have already observed, and is a striking and positive illustration of the fact that the intention of the committee was to provide, as a matter of public policy, that the right of renewal should be personal, and that the author, or those named as the persons in whom he is most concerned, should not in any way be cut off from the benefit of the new monopoly. As to the section which directly touches this case, the report observed as follows: —

"Section 24 deals with the extension of copyrights subsisting when this act goes into effect, and has the same provision regarding those who may apply for the extension of the subsisting term to the full term, including renewal, as is found in the preceding section regarding renewals generally."

On examining *Paige* v. *Banks*, as reported in 13 Wall., it

appears at page 609 that the contract on which the publisher relied was made in 1828, when the act of 1790 was in force, and when no rule of public policy such as we have explained existed or had been declared. The renewal, as appears on page 610, was under the act of February 3, 1831. It is true that the essential portion of the act of 1831 appears in the report of the case; and that act, as we have said, first exhibited the general rule of public policy now so plainly declared. Nevertheless, this fact was in no way commented on in the opinion of the court, and nothing in that opinion indicates that the court went beyond the state of the law in 1828 with reference to the question involved, except in saying, at the foot of page 614, that, on a fair and just interpretation of the terms of the original agreement, to attempt to apply the act of 1831 would lay the basis of too narrow a construction. All through the opinion the court refers to the original agreement made in 1828, without any indication that the court undertook to consider deliberately whether or not the act of 1831 affected, or could affect, the rights of the parties as they were originally established. So far as this is concerned, for aught that appears the court may have accepted the proposition made by the publisher here to the effect that a copyright arising under one statute becomes a vested interest which subsequent statutes cannot disturb. Certainly there is nothing in the decision in *Paige* v. *Banks* which justifies us in assuming that, as a result of that case, the decision would have been as it was if the original contract had been made after the act of 1831 came into force: and especially in the light of the accumulated evidence of a clearly intended public policy of the kind we have described, which existed when the questions arose with reference to the copyright here in question, we feel justified in giving full effect to the condition of the statutes as we now find them.

The decree of the Circuit Court is affirmed; and the appellees recover their costs of appeal.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE FIRST CIRCUIT.

October Term, 1910.

No. 909.
White-Smith Publishing Company,
Complainant, Appellant,
v.
Ira N. Goff et al.,
Defendants, Appellees.

ORDER OF COURT.
January 3, 1911.

Putnam & Lowell, JJ. Judge Aldrich is assigned to sit in this case, Judge Colt being necessarily absent.

By the Court,

Francis M. Fogarty

Clerk.

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Order of Court